

1224



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,344	10/29/1999	MICHAEL R. O'BRIEN	LOT9-99-0001	8551

21127 7590 12/23/2003

KUDIRKA & JOBSE, LLP
ONE STATE STREET
SUITE 800
BOSTON, MA 02109

EXAMINER

FIELDS, COURTNEY D

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 12/23/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/431,344

Applicant(s)

O'BRIEN ET AL

Examiner

Courtney D. Fields

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments, see pages 7-11, filed September 22, 2003, with respect to the rejection(s) of claim(s) 13, 19, and 20 under Baltzley U.S. Patent No. 6,292,895 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kocher U.S. Patent No. 5,903,651.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-12, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Mandelbaum et al. U.S. Patent No. 5,552,897. Referring to claims 1 and 7, Mandelbaum et al. discloses a method and apparatus comprising: when the sender is off-line, inserting an encryption flag in a header associated with the electronic message placing the header and the message in plain text in an outbox, when the sender is on-line, in response to the flag, requesting the digital certificate from the mail system, using the received certificate to encrypt the plain text mail message (See Column 4, lines 38-50)

Referring to claims 2, 8, and 14, Mandelbaum et al. discloses the claimed limitation of sending the encrypted mail message to the mail system (See Column 5, lines 8-11)

Art Unit: 2132

Referring to claims 3,9, and 15, Mandelbaum et al. discloses the claimed limitation when the sender is on-line, if the flag indicates that the message is encrypted, sending the encrypted mail message to the mail system (See Column 5, lines 4-11)

Referring to claims 4,10, and 16, Mandelbaum et al. discloses the claimed limitation of requesting the digital certificate from the mail system; and if the certificate is unavailable, informing the sender that the message cannot be encrypted (See Column 6, lines 50-53)

Referring to claims 5,11, and 17, Mandelbaum et al. discloses the claimed limitation of sending the unencrypted mail message in the outbox to the mail system when the message cannot be encrypted (See Column 6, lines 53-55)

Referring to claims 6,12, and 18, Mandelbaum et al. discloses the claimed limitation of using the identifying information to locate the recipient in the mail system and to retrieve the certificate (See Column 4, lines 52-65)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13,19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandelbaum et al. U.S. Patent No. 5,552,897 in view of Kocher U.S. Patent No. 5,903,651. Regarding claims 13,19, and 20, Mandelbaum et al. discloses the invention substantially as claimed. However, Mandelbaum et al. does not explicitly disclose a

computer program product used for encrypting electronic messages composed by a sender for delivery over a mail system to a recipient who holds a digital certificate.

Kocher discloses an apparatus and method for an email system with a digital certificate feature. Kocher discloses a secure email system (Column 1, line 41) used as an electronic communications protocol allowing two or more computers or other electronic devices exchange digital data or messages via a communications channel (Column 1, lines 57-60). The recipient of a digital certificate who trusts the issuing certificate authority (CA) can use the CA's already trusted public key to verify the signature. If the signature is valid and if the CA is trustworthy, the recipient can trust that the person identified in the certificate holds the private key corresponding to the public key in the certificate (Column 2, lines 4-11)

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of both Mandelbaum et al. and Kocher which will enable a user to compose an off-line message before incorporating a digital certificate which is used to verify messages exchanged via a communications channel. This will incline other email programs to have the ability to function on a central server without having a delay due to the transmission of emails.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 703-305-8293. The examiner can normally be reached on Mon - Thu 7:00 - 5:00 pm; off every Fri.

Application/Control Number: 09/431,344
Art Unit: 2132


Page 5

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

COF
cdf

December 15, 2003


GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100